REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1 and 7 have been amended and claims 5 and 6 have been canceled. No new matter has been added. Claim 4 was previously canceled, and claims 10 and 13-16 were previously withdrawn from consideration. Thus, claims 1-3, 7-9, and 11-12 are currently pending in the application and subject to examination.

I. Allowable Subject Matter

In the Office Action mailed August 9, 2006, the Examiner indicated that claims 7-9, 11, and 12 contain allowable subject matter. Although these claims were objected to as being dependent upon a rejected base claim, the Examiner indicated that these claims would be allowable if rewritten in independent form.

II. Objection to Figure 11

The Examiner objected to Figure 11, asserting that it should be labeled "Prior Art". The Applicants respectfully traverse this objection. Figure 11 is not Prior Art. Figure 11 is a view schematically showing a pixel array of a light receiving surface of a CMOS image sensor according to an embodiment of the present invention, as described on page 13, lines 4-10 of the specification. Therefore, the Applicants request the withdrawal of the objection to Figure 11.

III. Art Based Rejections

The Examiner rejected claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,590,198 to Zarnowski et al. ("Zarnowski"). Under 35 U.S.C. §

103(a), the Examiner rejected claims 5 and 6 as being unpatentable over Zarnowski in view of U.S. Patent No. 5,920,345 to Sauer ("Sauer"). It is noted that claim 1 has been amended and claims 5 and 6 have been canceled. To the extent that the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections as follows.

The Applicants' invention as now set forth in claim 1 is directed to an X-Y address type solid-state image pickup device including a noise cancel circuit, wherein the noise cancel circuit includes, for each of the vertical selection lines, a correlated double sampling circuit in which an electric charge corresponding to the image data after removal of the noise is held in a first capacitance, and the image averaging circuit includes **a** first averaging processing switch for connecting **a plurality** of the first capacitances to average a plurality of the electric charges.

In contrast to the invention recited in claim 1, Zarnoswki use **two or more** column select switches 96a, 96b, 96c for connecting more than one capacitance to average the image data. (See column 7, line 43 to column 8, line 19 and Figure 4 of Zarnowski).

Sauer fails to cure the deficiency in Zarnowski.

For at least this reason, the Applicants submit that claim 1 is allowable over the cited references. As claim 1 is allowable, the Applicants submit that claims 2-3, 7-9, and 11-12, which depend from allowable claim 1, are therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of

obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 4 and 5. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into allowable form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 024014-00003.

Respectfully submitted,

Arent Fox PLLC

Sheree T. Rowe
Attorney for Applicants
Registration No. 59,068

Customer No. 004372
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 715-8492
Facsimile No. (202) 638-4810